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| 09/630,000  | 08/01/2000  | Bruce Tockman        | 279.246US1              | 8111             |
| 21186   | 7590        | 12/16/2004           | EXAMINER                |                  |
| SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.<br>P.O. BOX 2938<br>MINNEAPOLIS, MN 55402 |             |                      | EVANISKO, GEORGE ROBERT |                  |
|   |             | ART UNIT             | PAPER NUMBER            |                  |
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/630,000  
Filing Date: August 01, 2000  
Appellant(s): TOCKMAN ET AL.

MAILED  
DEC 16 2004  
GROUP 3700

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Thomas Obermark  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed October 18, 2004.

**(1) Real Party in Interest**

A statement identifying the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) Status of Claims**

The statement of the status of the claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. In addition, only the amendments to the specification in the after final amendment of 5/24/04 have been entered.

**(5) Summary of Invention**

The summary of invention contained in the brief is correct.

**(6) Issues**

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

The rejection of claims 16-26 and 43-46 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) ClaimsAppealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

|           |                  |         |
|-----------|------------------|---------|
| 6,249,708 | Nelson et al     | 6-2001  |
| 5,935,159 | Cross, Jr. et al | 8-1999  |
| 4,640,983 | Comte et al      | 2-1987  |
| 6,400,992 | Borgersen et al  | 6-2002  |
| 5,849,032 | Van Venrooij     | 12-1998 |
| 5,052,407 | Hauser et al     | 10-1991 |

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

The 103 rejections in view of Nelson et al (6249708) have been withdrawn.

Claims 16-20, 24, 43, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cross, Jr. et al (5935159). Cross discloses:

in figure 1, the claimed “lead body extending from a proximal end to a distal end and having an intermediate portion therebetween”;

in figures 3-6 and 12 and in column 3, line 55, the claimed “lead body including two or more coradial individually insulated coradial conductors”;

in figure 10 and column 4, line 59, the claimed “coradial conductors are wound about a single axis”;

in column 2, lines 6-32 the claimed “electrode assembly including at least one electrode electrically coupled with at least one of the conductors”.

In addition, Cross states in column 2, line 52, to column 3, line 9, and shows in figures 3-6 and 12, that each conductor can be different conductors to accommodate different currents and

incorporates by reference Shoberg et al (US Patent No. 5,584873) and Laske et al (Patent No. 5,760,341). It is noted that Laske et al discuss the use of different conductors of different materials and different stiffness throughout his specification, and particularly in column 7, lines 34-43.

Therefore, Cross discloses the claimed invention and the use of different types of conductors, (stranded, coiled, having different diameters) individually insulated and wound except for the different conductors being different materials, wherein the first material has a different stiffness than a second material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the lead as taught by Cross, with insulated conductors being different materials, wherein the first material has a different stiffness than a second material since it was known in the art that leads are provided with insulated conductors being different materials, wherein the first material has a different stiffness than a second material to provide different and required impedance/resistances, different current carrying capabilities, and/or different flexibility/stiffness to the lead. In addition, the first conductor extending from a connector ring to an electrode will provide the claimed limitation of the first conductor only extending over the second section. Also, it is inherent that the different conductors will have different electrical properties.

Claims 21-23, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cross, Jr et al.

Cross discloses the claimed invention but does not disclose expressly the first material being MP35N and the second material being Pt/Ta (claims 21 and 22), one of the conductors having a heat setting capability (claim 25), and the lead having a two or three dimensional bias.

It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the lead as taught by Cross with the first material being MP35N and the second material being Pt/TA, because Applicant has not disclosed that the first material being MP35N and the second material being Pt/TA and the first conductor disposed only in the second and third sections provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with any two different materials having different stiffness for the conductors as taught by Cross in view of one having ordinary skill in the art, because it would provide a lead having different conductors with different stiffness to provide required current carrying capabilities and/or different flexibility/stiffness to the lead.

Therefore, it would have been an obvious matter of design choice to modify Cross to obtain the invention as specified in the claim(s).

In addition, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the lead as taught by Cross, with a conductor having heat setting capabilities and the lead having a two or three dimensional bias since it was known in the art that leads are provided with conductors having heat setting capabilities to allow the lead to be easily shaped into a bias configuration and since it was known in the art that leads are provided with a two or three dimensional bias to allow the lead to be easily located in a particular part of the body and allow the lead to remain in that location.

**(11) Response to Argument**

The 103 rejections in view of Nelson et al (6249708) have been withdrawn. Nelson shows coradial wound conductors that are insulated from each other by the inner body member, but does not show the claimed “individually insulated” conductors.

The argument on page 15 that no objective reference was provided in a fully developed rejection under 35 USC 103 in view of Cross establishing that it is well known in the art to use “insulated conductors being different materials...since it was known in the art that leads are provided with insulated...different flexibility/stiffness to the lead” is not persuasive. The MPEP states in 2144 and 2144.03 that rationale supporting a rejection under 35 USC 103 may be reasoned from common knowledge in the art. The applicant asked for references in the amendment and remarks of 12/22/03 to support the obviousness rejection and the examiner provided the references. Patent number 4,640,983 to Comte and patent number 6400,992 to Borgersen et al were provided to show that it is obvious to use conductors of different materials and different stiffness to provide different and required impedance/resistances, different current carrying capabilities, and/or different flexibility/stiffness to the lead. In addition, it is noted that Cross incorporates by reference the patent of Laske et al. which discusses the use of different materials and stiffness.

The argument on page 15 that none of the references (Comte and Borgersen) were used in a fully developed rejection under 35 USC 103 is not persuasive since the examiner provided the references upon applicant’s request and to show that it is well known in the art to use conductors of different materials having different stiffness.

The argument of page 16 that the rejection does not state how or why Cross would be in need of conductors using different materials and having different stiffness is not persuasive since the examiner provided the motivation that “it is obvious to use conductors of different materials and different stiffness to provide different and required impedance/resistances, different current carrying capabilities, and/or different flexibility/stiffness to the lead”. In addition, it is noted that Cross uses different conductors and incorporates by reference the patent to Laske et al.

The argument on page 16 that Cross teaches away from the proposed modification because Cross teaches the use of sections of different materials to provide different stiffness to the lead is not persuasive since Cross does not preclude the use of conductors having different stiffness. Stiffness can be provided to the lead in multiple ways, such as by using different materials for the lead body, different materials for the conductors, additional conductors in certain sections of the lead body, stiffening stylets or a combination of any of the preceding. Although Cross mentions in one section an alternate embodiment for providing different flexibility and stiffness to the lead, Cross does not state this is the only way to provide different stiffness to the lead or that different conductors having different stiffness can not be used.

The arguments on page 19 that no objective reference was provided in a fully developed rejection under 35 USC 103 and that the rejection does not state how or why Cross would be in need of the conductors having heat setting capabilities are not persuasive. The applicant asked for references in the amendment and remarks of 12/22/03 to support the obviousness rejection, and the examiner provided the references. Patent number 5,849,032 to Van Venrooij and patent number 5,052,407 to Hauser show that it is well known in the art to provide leads with conductors formed of heat setting material in order to provide the lead with a two or three

dimensional bias to allow the lead to be easily located in a particular part of the body and allow the lead to remain in that location.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

George R Evanisko  
Primary Examiner  
Art Unit 3762

12/13/04

GRE  
December 13, 2004

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Angela Sykes  
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